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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/387,513	09/01/1999	KIYOSHI TOYODA	P18445.P04	2687
7055	7590	12/15/2004	EXAMINER	
GREENBLUM & BERNSTEIN, P.L.C. 1950 ROLAND CLARKE PLACE RESTON, VA 20191			PARK, CHAN S	
			ART UNIT	PAPER NUMBER
			2622	
DATE MAILED: 12/15/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/387,513	TOYODA, KIYOSHI	
	Examiner	Art Unit	
	CHAN S PARK	2622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

2. Applicant's amendment was received on 10/20/04, and has been entered and made of record. Currently, **claims 13-26** are pending.

Response to Arguments

3. Upon further consideration, a new ground(s) of rejection is made in view of Zuili et al. U.S. Patent No. 6,145,084 (hereinafter Zuili).

EDWARD COLES
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 25 and 26 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Zuili.

4. With respect to claim 25, Zuili teaches a capability exchanging method for controlling an image communication apparatus (device (A) 14) connected with a first server apparatus (verifying server 12) via a LAN (network between the device (a) and the verifying server 12) and a second server apparatus (other Web sites servers in col. 6, lines 8-19) via the Internet, at least one of the first server apparatus and the second server apparatus storing capabilities regarding facsimile data that a receiving facsimile (device (B) in col. 4, line 8 and col. 10, line 25) is capable of receiving (col. 5, lines 12-61), the capability exchanging method comprising:

accessing the first server apparatus (col. 5, lines 12-27);

determining whether or not the first server stores the capabilities regarding facsimile data that the receiving facsimile is capable of receiving (col. 5, lines 12-27);

obtaining, from the second server apparatus, capabilities regarding facsimile data that the receiving facsimile is capable of receiving, when the first server apparatus is

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determined not to store the capabilities regarding facsimile data that the receiving facsimile is capable of receiving (col. 6, lines 5-19);

storing, in the first server apparatus, the capabilities regarding facsimile data that the receiving facsimile is capable of receiving, the capabilities being obtained from the second server (col. 6, lines 5-19).

Examiner read the network between the device (a) and the verifying server 12 as a LAN since Zuili is improving the image communication apparatus in a LAN (col. 2, lines 10-12 & col. 4, line 64 – col. 5, line 2).

5. With respect to claim 26, Zuili discloses an image communication apparatus connected with a receiving facsimile (device (B) in col. 4, line 8 and col. 10, line 25) via a server apparatus on the Internet, the image communication apparatus comprising:

a communicator configured to communicate with a first server apparatus and with a second server apparatus via the Internet (fig. 1 and col. 6, lines 8-19);

a controller, when the first server apparatus is determined not to store the capabilities regarding facsimile data that the receiving facsimile can receive, is configured to obtain, from the second server apparatus, the capabilities regarding facsimile data that the receiving facsimile can receive and to store, in the first server apparatus, the obtained capabilities regarding facsimile data that the receiving facsimile can receive (col. 6, lines 5-19).

Also, arguments analogous to those presented for claim 25, are applicable.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 13-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zuili in view of Toyoda et al. Japanese Patent Publication No. 09-116728 (hereinafter Toyoda).

6. With respect to claim 13, Zuili discloses an image communication apparatus (device (A) 14) connected with a receiving facsimile (device (B) in col. 4, line 8 and col. 10, line 25) via a server apparatus (verifying server) on the Internet, the image communication apparatus comprising:

a communicator configured to communicate with a first server apparatus and with a second server apparatus via the Internet (fig. 1 and col. 6, lines 8-19);

a controller configured to access the first server apparatus to obtain capabilities regarding facsimile data that the receiving facsimile can receive (col. 5, lines 12-27),

the controller being further configured, when the first server apparatus is determined not to store the capabilities regarding facsimile data that the receiving facsimile can receive, to obtain, from the second server apparatus, the capabilities regarding facsimile data that the receiving facsimile can receive, and to transform image data, based on the obtained capabilities regarding facsimile data that the receiving facsimile can receive (col. 5, lines 24-61 & col. 6, lines 5-19).

Also, arguments analogous to those presented for claim 25, are applicable.

Zuili does not disclose expressly that controller converts the transformed image data into data for Internet transmission and transmits the converted data to the receiving facsimile.

Toyoda, the same field of endeavor of the network facsimile, discloses an image communication apparatus connected on the Internet (paragraph 12) wherein a controller is configured to obtain capabilities regarding facsimile data that the receiving facsimile can receive, to transform image data, based on the obtained receiving facsimile unit information or capabilities regarding facsimile data that the receiving facsimile can receive, *to convert the transformed image data into data for Internet transmission (E-mail), and to transmit the converted data to the receiving facsimile (paragraphs 19 and 20).*

At the time of the invention, it would have been obvious to one of ordinary skill in the art to implement the system for converting image data into the data for Internet transmission of Toyoda into the image communication apparatus of Zuili.

The suggestion/motivation for doing so would have been to convert the image data when the receiving facsimile has a capability of receiving facsimile data in an email format (col. 5, lines 29-61).

Therefore, it would have been obvious to combine Zuili with Toyoda to obtain the invention as specified in claim 13.

7. With respect to claim 14, Zuili further discloses that the first server apparatus is a local server apparatus in a local area network containing the image communication

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apparatus, and the second server apparatus is a global server apparatus in a global area network connected with the local area network (col. 6, lines 10-13).

Also, arguments analogous to those presented for claim 25, are applicable.

8. With respect to claim 15, Zuili discloses image communication apparatus for communicating in E-mail communication (col. 4, line 48) and Toyoda discloses the facsimile communication using email address (fig. 12). Referring to fig. 12, it would have been obvious to one of ordinary skill in the art to recognize that servers are generally required in the email transmission over the Internet network. Since a DNS server uses the method of transmitting a fax message in a standard email format, the Office interprets the second server as the DNS server for storing the capabilities in the combined invention of Zuili and Toyoda.

9. With respect to claim 16, Zuili discloses a server apparatus connected with a transmitting facsimile and a receiving facsimile via the Internet, the server apparatus comprising;

a memory configured to store capabilities regarding facsimile data that the receiving facsimile can receive (col. 5, lines 21-28).

With respect to rest of claim, arguments analogous to those presented for claim 13, are applicable.

10. With respect to claim 17, arguments analogous to those presented for claims 13 and 25, are applicable.

11. With respect to claim 18, arguments analogous to those presented for claims 13 and 25, are applicable.

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12. With respect to claim 19, refer to col. 6, lines 8-19 of Zuili.
13. With respect to claim 20, Zuili further discloses the image communication apparatus, wherein the capabilities of the receiving facsimile includes one of resolution, a paper size, a compression format, and an encryption format that are utilized for a facsimile communication (col. 5, line 29 – col. 6, line 7).
14. With respect to claim 21, Zuili further discloses the image communication apparatus, wherein the receiving facsimile is determined by the image communication apparatus (col. 5, lines 12-14).
15. With respect to claims 22 and 23, arguments analogous to those presented for claim 20, are applicable.
16. With respect to claim 24, Zuili further teaches the method of storing, in the first server apparatus, the capabilities regarding facsimile data that the receiving facsimile is capable of receiving, the capabilities being obtained from the second server (col. 6, lines 8-19).

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Conclusion


17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHAN S PARK whose telephone number is (703) 305-2448. The examiner can normally be reached on M-F 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached on (703) 305-4712. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

csp
December 10, 2004

Chan S. Park
Examiner
Art Unit 2622


EDWARD COLES
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600